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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/145,987    09/03/98    NAKANISHI    Y    2224-0142P

002292    HM12/1221  
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EXAMINER

WHITE, E

ART UNIT

PAPER NUMBER

1623

DATE MAILED:

12/21/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/145,987

Applicant(s)  
NAKANISHI et al.

Examiner  
Everett White

Group Art Unit  
1623



☒ Responsive to communication(s) filed on Oct 16, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-13 and 15-22 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-13 and 15-22 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

*Howard C. Lee*

Howard C. Lee  
Primary Examiner  
Art Unit 1623

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Amendments E and F filed September 18, 2000 and October 16, 2000 has been received and entered into the record.
2. Claims 1-13 and 15-22 are pending in the case.
3. All 35 U.S.C. statutes not cited in this Office action can be found cited in full in a previous Office action.

### **35 U.S.C. 112, First Paragraph Rejection**

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amendment to Claim 1 in features (ii) and (iii) which indicate that the features were intended to generate free carboxyl groups is not supported in the instant specification. While the specification does support the generation of free carboxyl groups in feature (i), the generation of free carboxyl groups involving the subject matter of features (ii) and (iii) in Claim 1 is not disclosed in the instant specification.

### **35 U.S.C. 103 Rejection**

6. Claims 1-13 and 15-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al (US Patent No. 3,816,150) for the reasons already of record on pages 4 and 5 of the Office action mailed February 25, 1999.

7. Applicant's arguments filed September 18, 2000 have been fully considered but they are not persuasive. Applicants argue against the rejection on the grounds that the Ishii et al patent fail to teach the characteristics (i)-(iii) of the present invention. This argument is not persuasive since the Ishii et al patent does indeed teaches a cellulose acetate comprising at least one the claimed characteristics. For example, Claim 1 reads on a cellulose acetate whereby feature (ii) may be selected, wherein feature (ii) is further limited to features of the cellulose acetate which may be selected to be a cellulose acetate which contains an acid having an acid dissociation exponent  $pK_a$  of 1.93 to 4.50 in water. See page 14, line 18 to page 15, line 23 of the instant specification for examples of aliphatic monocarboxylic acids that have an acid dissociation exponent  $pK_a$  within the claimed 1.93 to 4.50 value in water that may be present with the claimed cellulose acetate. The list includes acetic acid and succinic acid, both of which are disclosed with the cellulose acetate of the Ishii et al patent. Accordingly, the rejection of Claims 1-13 and 15-22 under 35 U.S.C. 103(a) as being unpatentable over the Ishii et al patent is maintained.

8. Claims 18-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Seo et al (US Patent No. 5,240,665) in view of Ishii et al (US Patent No. 3,816,150) for the reasons already of record on page 5 of the Office action mailed February 25, 1999.

9. Applicant's arguments filed September 18, 2000 have been fully considered but they are not persuasive. The Seo et al patent is cited to show that the presence and use of a dope with cellulose acetate, as set forth in instant claims 18-21, is well known in the art. The patentability of instant claims 18-21 are dependent upon the patentability of the instantly claimed cellulose acetate as set forth in instant claim 1. However, as discussed in the above rejection, the cellulose acetate do not appear to be patentable over the Ishii et al patent. Therefore, the rejection of claims 18-21 under 35 U.S.C. 103(a) as being unpatentable over the Seo et al and Ishii et al patent is also maintained for the reasons disclosed in the above art rejection over the Ishii et al patent alone.

10. **Summary:** All the claims are rejected.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist, can be reached on (703) 308-1701. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

*E. White*

White  
December 19, 2000

*Howard C. Lee*

Howard C. Lee  
Primary Examiner  
Art Unit 1623